

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

**MAILED**

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

AUG 28 2003

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BARNEY D. VISSER

Appeal No. 2001-2403  
Application No. 08/851,040

ON BRIEF

Before THOMAS, BARRETT and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 21-26 and 28-36. Claims 1-4, 6-16 and 18-20 have been indicated as allowable in the Examiner's answer.

We reverse.

BACKGROUND

Appellant's invention is directed to a method for facilitating the presentation of inventory items and for providing access to such items.

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Representative independent claim 21 is reproduced below:

21. A method for presenting inventory items, comprising:

providing at least three stores which are separated from each other by elongate walls, each wall having a doorway, with the doorways being aligned with each other, wherein each store has its own outside entrance;

entering into a parking facility adjacent the outside entrances;

selecting one of the outside entrances and entering into the selected outside entrance directly from the parking facility;

moving to and standing in an aisle which passes through each doorway;

looking down the aisle and visualizing at least some of the interior of each store,

selecting an item within one of the stores; and

purchasing the item while within the store.

Claims 21-26 and 28-36 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.<sup>1</sup>

Rather than reiterate the viewpoints of the Examiner and Appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 24, mailed April 10, 2001) for the Examiner's reasoning and the appeal brief (Paper No. 23, filed February 20, 2001) for Appellant's arguments thereagainst.

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<sup>1</sup> The 35 U.S.C. § 102(b) rejection of claims 1-4, 6-16 and 18-36 as being anticipated by Searcy, as stated in the final rejection (Paper No. 21, mailed September 25, 2000), has been withdrawn by the Examiner.

OPINION

The Examiner asserts that the claims are directed to non-statutory subject matter, in particular, to a method of doing business (final rejection, page 2). The Examiner adds that the claims require a human to visualize how products are displayed, which requires the thought process of a human to select a store based on the facility layout (id.). The Examiner concludes that "the inclusion of the human thought process in the method of doing business fails to fall within the safe harbors of business methods" (id.).

Appellant responds by asserting that the claims are not drawn to a method of doing business (brief, page 5). Additionally, Appellant asserts that the mere inclusion of a human-performed step does not make a process claim non-statutory (id.). Appellant further argues that since the claimed subject matter does not include a computer algorithm, the Examiner's reliance on MPEP § 2106 is misplaced (brief, pages 5 & 6).

In response, the Examiner argues that the claims require the use of human thought and movement, such as a human entering into a parking facility (answer, page 3). The Examiner further points out that the claims include purchasing of an item and therefore, set forth a business method (answer, page 4). The Examiner also

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argues that such claims must fall within the safe harbors listed in MPEP § 2106 in order to be statutory (id.).

We disagree with the Examiner that the claims, in order to be statutory, must fall within the required safe harbors since the appealed claims do not recite an algorithm performed on a computer. Furthermore, contrary to the Examiner's position, human involvement in performing some of the steps of the claimed process is not enough to make the claims non-statutory. Although processes that require humans to subjectively make a selection or judgment may be non-statutory or indefinite, here the outcome of the claimed process does not depend on any subjective judgments, but rather includes objective actions by humans such as entering, moving, looking and purchasing a selected item.

We also find that a prima facie case of non-statutory subject matter has not been provided as the Examiner has failed to follow the guidelines set forth in State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998), AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999) and Ex Parte Bowman, 61 USPQ2d 1669 (Bd. Pat. Appl. & Int. 2001)(unpublished). The Examiner appears to have ignored that a determination of non-statutory subject matter needs more than stating that the claimed

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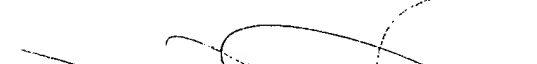
steps are directed to a method of doing business or do not fall within one of the safe harbors recognized for computer related inventions. The analysis, in fact, should include a clear delineation of whether the claimed process steps constitute a practical application of a process which produces "a useful, concrete and tangible result." See State Street, 149 F.3d at 1373, 47 USPQ2d at 1600-01. The Examiner has not provided any such analysis in support of the alleged lack of utility of the claimed subject matter within the technological arts. Accordingly, the rejection of claims 21-26 and 28-36 under 35 U.S.C. § 101 cannot be sustained.

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## CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 21-26 and 28-36 under 35 U.S.C. § 101 is reversed.

REVERSED

  
JAMES D. THOMAS )  
Administrative Patent Judge )

*Lee E. Barrett*  
LEE E. BARRETT  
Administrative Patent Judge

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